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OFFICE OF PETITIONS

In re Application of :
Glidden, et al. :
Application No. 10/710,361 : ON APPLICATION FOR
Filed: July 3, 2004 : PATENT TERM ADJUSTMENT
Attorney Docket No. 384.8613USU :

This is in response to the "APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 CFR § 1.705(b)" filed June 23, 2010. Applicants request that the determination of patent term adjustment be corrected from eight hundred and eleven (811) days to one thousand, four hundred and eighteen (1,418) days. Applicants request this correction, in part, on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, the application for patent term adjustment under 37 CFR 1.705(b) is **DISMISSED as PREMATURE**.

Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.702(b). (This is true even where a request for continued examination (RCE) was filed). The computer will not undertake the § 1.702(b) calculation until the actual date of issuance of the patent has been determined. Likewise, the computer will not calculate any further Office delay under § 1.702(a)(4) or applicant delay under § 1.704(c)(10) until the actual date of issuance of the patent has been determined. As such, the Office can not make a determination on the correctness of the patent term adjustment until the patent has issued.

Requesting reconsideration of the patent term adjustment to be indicated on the patent under 37 CFR 1.705(b) based on the initial determination of patent term adjustment and a projected issuance date of the patent (or even the filing date of the request for continued examination) is premature. Accordingly, it is appropriate to dismiss as premature such a request.

Rather than file an application for patent term adjustment under 37 CFR 1.705(b) contesting the 37 CFR 1.702(b) calculation at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term adjustment pursuant to 37 CFR 1.705(d). As the USPTO does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent. However, as to all other bases for contesting the initial determination of patent term adjustment received with the notice of allowance, applicant must timely file an application for patent term adjustment prior to the payment of the issue fee¹.

It is noted that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

¹ For example, if applicant disputes both the calculation of patent term adjustment under 37 CFR 1.702(a)(1) for Office failure to mail a first Office action or notice of allowance not later than fourteen months after the date on which the application was filed and under 37 CFR 1.702(b) for Office failure to issue a patent within three years of the actual filing date of the application, then applicant must still timely file an application for patent term adjustment prior to the payment of the issue fee to contest the calculation of Office delay in issuing a first Office action or notice of allowance. See 37 CFR 1.705(b) and 35 U.S.C. 154(b)(3)(B). A dispute as to the calculation of the §1.702(a)(1) period raised on request for reconsideration of patent term adjustment under 37 CFR 1.705(d) will be dismissed as untimely filed.

(i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

It is further noted that a Request for Continued Examination (RCE) was filed in this application on November 19, 2009.

Deposit account 01-0467 will be charged \$200.00 for the fee set forth in 37 CFR 1.18(e). No additional fees are required.

To the extent that applicants otherwise requests reconsideration of the patent term adjustment at the time of the mailing of the notice of allowance, the application for patent term adjustment is dismissed.

Applicants maintain that the reductions of 63 days and 65 days to the patent term adjustment under 37 CFR 1.704(b) are inaccurate. More specifically, applicants state:

The first period of delay runs from 1 day after the 3-month period for reply for the first Office action mailed March 26, 2008 to the mailing date of the actual response to that first action, August 26, 2008. Thus the first period runs from March 27, 2008, to August 26, 2008 for 61 days. The second period of delay runs from 1 day after the 3-month period for reply for the non-final Office action mailed December 23, 2008 to the mailing date of the actual response to the first office action, May 21, 2009. Thus, the second period runs from March 24, 2008 to May 21, 2009 for 59 days.

Applicants' argument is not persuasive. Pursuant to 37 CFR 1.704(b), the periods of adjustment of the term of the patent were properly reduced by 63 days and 65 days, respectively. These determinations were based on the date of receipt of the responses in the Office, not the mailing date of the responses as applicants assert. The Office notes that 35 U.S.C. 154(b)(2)(C)(ii) does not require that a reply be filed in the Office within its three month grace period, but simply specifies that there is this three month period. For purposes of the determination of reduction to the patent term adjustment, no consideration is given for the date the response was deposited with the United States Postal Service under 37 CFR 1.8. A review of the application file history reveals that the

responses filed August 28, 2008, and May 27, 2009, both contained certificate of mailings under 37 CFR 1.8, however, the provisions of 37 CFR 1.8 have no effect on three month period for reply set forth under 37 CFR 1.704(b). Accordingly, the reductions to the patent term adjustment of 63 days and 65 days were warranted and will not be removed.

Applicants are reminded that any delays by the Office pursuant to 37 CFR 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Any request for reconsideration of the patent term adjustment indicated on the patent must be timely filed within 2 months after issuance pursuant to 37 CFR 1.705(d) and must include payment of the required fee under 37 CFR 1.18(e).

The Office of Data Management has been advised of this decision. This application is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries specific to this decision should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Anthony Knight
Director
Office of Petitions